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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,217	02/25/2004	Edmund Arthur Flexman	CL1375USCNT	3035
23906 7590 12/04/2008 E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1122B 4417 LANCASTER PIKE WILMINGTON, DE 19805				
EXAMINER RONESL VICKERY M				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 12/04/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

Office Action Summary

Application No.

10/786,217

Applicant(s)

FLEXMAN ET AL.

Examiner

VICKEY RONESI

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 10/17/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 4/23/2008. In particular, the specification has been amended to further describe Magnifin® H-51C and claim 1 has been amended to substitute plural term "saturated fatty acids" with singular term "saturated fatty acid". Thus, the following action is properly made final.

Priority

4. The claim to priority is not perfected because the claim to priority in the first line of the specification is incorrect. Specifically, the specification should not read that "[t]his application is a continuation of application no. 10/786,217, filed on Feb 25, 2004, now abandoned" because 10/786,217 is the serial no. for the instant application.

Appropriate correction is required.

Specification

5. The amendment filed 10/17/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: that Magnifin® H-51C is an

aminopolysiloxane-coated magnesium hydroxide. While applicant has cited two US patent documents (US 6,462,121 and US 6,576,160) as defining Magnifin® H-51C, these US patent documents were published after the filing date of the instant invention. Therefore, there is no evidence that applicant had knowledge at the time of invention that Magnifin® H-51C is an aminopolysiloxane-coated magnesium hydroxide.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

6. Claim 5 is objected to because the plural term “saturated fatty acids” does not have full antecedent basis given that only the singular “saturated fatty acid” is recited in claim 1, on which claim 5 is dependent.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. Claims 1-5, 7, 8, 10-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metzenmacher et al (US 5,827,906) in view of Hyde (US 4,399,246).

The rejection is adequately set forth in paragraph 9 of Office action mailed on 4/23/2008 and is incorporated here by reference.

Response to Arguments

8. Applicant's arguments filed 10/17/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that semi-open transitional claim language "consisting essentially of" with respect to the coating excludes the coating of Metzénmacher et al which requires the presence of a siloxane component.

In response, while it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. siloxane component of the coating, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention, See MPEP 2111.03. Moreover, the statement that the siloxane component is excluded from applicant's invention is a conclusory statement with no evidentiary weight, i.e., attorney's statements are not a substitute for factual evidence. Case law holds that "[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/25/2008

Vickey Ronesi

/V. R./

Examiner, Art Unit 1796

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796